

S/N 10/580,169

PATENT

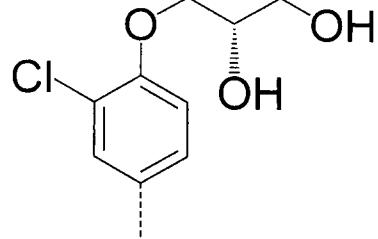
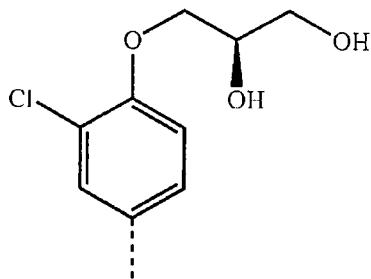
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Christoph Binkert et al.	Examiner:	Laura Lynne Stockton
Serial No.:	10/580,169	Group Art Unit:	1626
Filed:	Dec. 1, 2006	Docket No.:	AC-44-US
Title:	NOVEL THIAZOLIDIN-4-ONE DERIVATIVES	Patent No.	7,435,828

**REQUEST FOR RECONSIDERATION
OF A CERTIFICATE OF CORRECTION**

Decisions and Certificate of Correction Branch
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

The above-referenced issued U.S. Patent No. 7,435,828 contains a number of errors. On January 18, 2011, Patentees filed a request for a certificate of correction to correct various chemical structural errors and to delete the entire Column 97 and up to line 39 of Column 98. A decision was mailed February 17, 2011, granting in-part and denying in-part said request. In particular, the Examiner denied the request to replace the structure of Example 86 in Column 77, lines 40-45:



with

arguing that the correction of Example 86 would introduce new matter. In particular, the Examiner argued that the R variable substituent printed in the patent for Example 86 has the exact stereochemistry as found on the last line on page 70 of the originally filed specification. The Examiner also denied the request to delete Column 97 in whole and Column 98 in part,

noting that deletion of column 97 and part of column 98 by certificate of correction is not proper for this type of change. Patentees hereby request reconsideration of the decision for reasons explain below.

Patentees' request to correct Example 86 does not introduce new matter because the bond linking the hydroxy substituent to the chiral carbon of the structure of Example 86 on page 70 of the specification originally submitted is in fact a dashed (or broken) wedge, signifying a bond pointing away from the reader behind the plane of the paper. The corresponding bond that appears in the structure of Example 86 in the published issued patent 7,435,828, on the other hand, is a solid wedge, signifying a bond pointing towards the reader out of the plane of the paper. Therefore, the structure as published in the issued patent is incorrect. This error may have stemmed from the scanning process of the originally submitted specification, wherein the dashed (or broken) wedge in Example 86 appears too dark and is mistaken as a solid wedge. This is an obvious mistake as the dashed (or broken) wedge feature is more prominent and can be seen more clearly when looking at the magnified structure of example 86 in the corresponding PCT Publication WO 2005/054215, which PCT publication contains the same subject matter as the originally submitted specification (with the exception of page 79 of the specification as explained on page 3 below). When comparing the structure of Example 86 to that of Example 85, there is no difference between the two structures except the stereochemistry of the carbon carrying the hydroxy substituent. From looking at these two examples, it is clear that the two structures are not intended to cover the same exact compound (as published in the issued patent) because there is no reason to list the compound twice. In reading the rest of the specification, it is also clear that examples 85 and 86 are intended to be different as they are explicitly provided for on page 20, lines 7-10 of the originally submitted specification. In fact, the compound disclosed on lines 7-8 of page 20 ((R)-5-[3-chloro-4-(2,3-dihydroxy-propoxy)-benz[Z]ylidene]-2-([Z]-propylimino)-3-o-tolyl-thiazolidin-4-one) is example 85 while the compound disclosed on lines 9-10 of page 20 ((S)-5-[3-chloro-4-(2,3-dihydroxy-propoxy)-benz[Z]ylidene]-2-([Z]-propylimino)-3-o-tolyl-thiazolidin-4-one) is example 86. For reasons stated herewith, Patentees respectfully submit that the bond linking the hydroxy substituent to the chiral carbon of the structure of Example 86 on page 70 of the specification originally submitted is in fact a dashed (or broken) wedge and that the request to replace the structure does not introduce new matter. Reconsideration is earnestly requested.

With respect to the request to delete Column 97 in whole and Column 98 in part, Patentees submit that when filing the national phase application, page 79 of the specification was inadvertently submitted during national phase entry, which page 79 was erroneously omitted during the PCT stage. This mistake occurred through error and without any deceptive intent. The entire column 97 and part of column 98 (or page 79 of the originally submitted specification) contain mass spectrometry liquid chromatography data for examples 118-120 and 121-123 and proton nuclear magnetic resonance data of example 120. Columns 97 and 98 also list the starting materials and methods D or E for making examples 118-123. Patentees respectfully submit that methods of making the compounds of the invention are disclosed elsewhere in the originally submitted application. In particular, Methods D and E are disclosed on Column 13 and 14 of the printed issued patent (or page 22 of the originally submitted application). As such, the compounds of the invention are fully supported and enabled. Therefore, Patentees request that the entire Column 97 and lines 1-39 of Column 98 of the issued patent No. 7,435,828 to be deleted via certificate of correction.

Should the request to delete columns 97 in whole and column 98 in part via certificate of correct be denied, Patentees request in the alternative that the relationship of the current application to prior-filed applications be amended from “an application under 35 U.S.C. § 371” to “this application is a continuation-in-part of PCT/EP04/12953 filed on November 16, 2004, which claims the benefit of PCT/EP03/13072, filed on November 21, 2003”. MPEP 201.11, Section V provides that “[a] petition under 37 C.F.R. 1.78(a)(3) and a surcharge would not be required for correcting a timely submitted benefit claim for the following situations: (A) changing the relationship of the applications (e.g., changing from “continuation” or “divisional to “continuation-in-part” or from “continuation-in-part” to “continuation” or “divisional”).” MPEP 201.11 (emphasis added). Therefore, Patentees respectfully request in the alternative that a correction be made via certificate of correction so as to reflect that the current application is a continuation-in-part of PCT/EP04/12953 filed on November 16, 2004, which claims the benefit of PCT/EP03/13072, FILED ON November 21, 2003.

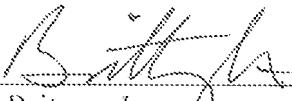
Finally, Patentees thank the Examiner for granting the request to correct the remaining errors in the issued patent. In this regard, the Examiner noted that a certificate of correction will be issued. 37 C.F.R. § 1.322(b) provides, however, that “[i]f the nature of the mistake on the part of the Office is such that a certificate of correction is deemed inappropriate in form, the

Director may issue a corrected patent in lieu thereof as a more appropriate form for certificate of correction, without expense to the patentee". Due to the large number of errors in the structures that occur throughout the issued patent, Patentees respectfully request for the issuance of a corrected patent in lieu of the certificate of correction.

It is believed no fees are required. Should this be incorrect, the Commissioner is authorized to charge any additional fees, or credit any overpayment, to deposit account No. 50-4255.

Respectfully submitted,

Date 03 25 2011



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